

**REMARKS**

Claims 1-13 are all the claims pending in the application.

**1. Improper Analysis and/or Finality of Office Action**

As an initial matter, Applicants submit that the Examiner did not analyze the claims with the amendments as entered in the filing of January 26, 2005. These amendments must be entered as a matter of right. Since the Examiner did not consider the claim amendments, the Examiner's analysis of the claims was improper and did not conform to MPEP guidelines (MPEP 2163.III at page 2100-176).

In addition, the Examiner applied new art without considering the claim amendments and issued a Final rejection, which is also improper.

Accordingly, Applicants request that the amendments to claims 1 and 3 in the present Amendment be entered as a matter of right.

Even if the amendments are not entered, Applicants still request a full analysis of all the claims since the analysis in the Office Action of June 13, 2005, was improper.

**2. Claim Rejections Under 35 U.S.C. § 112**

The Examiner has rejected claims 1-12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, as best understood, the Examiner contends that the Specification only supports  $\pm 30^\circ$  for the claimed  $\alpha$  and  $\beta$  angles, which includes zero degrees. Accordingly, the Examiner contends that the removal of zero degrees from the claims would constitute new matter since a narrower range is not supported.

Applicant submits that the claimed transfer magnetic field may be applied at various angles as evidenced by the data in Tables 1 and 2 of the Specification. These Tables, along with the rest of the Specification, provide enabling disclosure to one skilled in the art to practice the claimed invention. Since the Specification is enabling for angles that are  $\pm 30^\circ$ , it stands to reason that the Specification is also enabling for ranges that are narrower than  $\pm 30^\circ$ . The fact that Applicants choose not to protect a certain point or range of points of a parameter that is fully disclosed and supported in the Specification does not constitute new matter.

**3. Claim Rejections Under 35 U.S.C. § 102**

The Examiner has rejected claims 1-13 under 35 U.S.C. § 102(e) as being anticipated by Komatsu et al. (US 6,570,724) [“Komatsu”]. For at least the following reasons, Applicants traverse the rejection.

Claim 1 recites a magnetic transfer method in which “an application angle  $\beta$  of the transferring magnetic field is  $0 < \beta \leq 30^\circ$  or  $-30^\circ \leq \beta < 0$  with respect to the track direction on a plane parallel to the slave surface.” The Examiner concedes that Komatsu does not disclose the claimed range of the application angle  $\beta$  of the transferring magnetic field since he clearly states that “[t]he application angle of the transferring magnetic field is inherently disclosed by the reference as  $0^\circ$  since the magnetic field is being applied in the direction of track on the slave medium (i.e. in the tangential direction of a circular arc).” Office Action at page 4.

Accordingly, Applicants submits that a rejection under §102 is clearly improper.

Because independent claims 2-4 recite a feature similar to that given above with respect to claim 1, Applicants submit that these claims are patentable for at least reasons similar to those given above with respect to claim 1.

Applicants submit that claims 5-12 are patentable at least by virtue of their respective dependencies.

Claim 13 recites a magnetic transfer apparatus that comprises a “magnetic generating device [that] is rotatably mounted on the magnetic transfer apparatus such that an application angle  $\alpha$  of the transferring magnetic field by the magnetic field generating device is adjustable within a range of  $\pm 30^\circ$  ... and an application angle  $\beta$  of the transferring magnetic field by the magnetic field generating device is adjustable within a range of  $\pm 30^\circ$ .” (emphasis added). The Examiner does not comment on this feature.

Applicants submit that Komatsu does not disclose or suggest that the magnets of Komatsu are rotatably mounted. In fact, the Examiner concedes that application angle  $\beta$  of Komatsu is inherently  $0^\circ$ , therefore, there is no disclosure in Komatsu of a rotation in at least the claimed range for application angle  $\beta$ . Accordingly, Komatsu does not disclose the claimed magnetic generating device that is rotatably mounted, and claim 13 is patentable.

Because independent claims 1 and 3 recite a feature similar to that given above with respect to claim 13, Applicants submit that claims 1 and 3 are additionally patentable for at least the reasons given above with respect to claim 13.

**4. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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**23373**

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